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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,467	07/07/2003	Joseph W. Prenz	1128.017	9336

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EXAMINER

YIP, WINNIE S

ART UNIT PAPER NUMBER

3637

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,467

Applicant(s)

PRENN ET AL.

Examiner

Winnie Yip

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13-17 and 22-27 is/are rejected.
- 7) ☒ Claim(s) 10, 11, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Part II DETAILED ACTION

This office action is in response to applicant's amendment filed on March 29, 2005.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

1. Claims 1-2, 5-8, 22-23, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Osaka et al. (US Patent No. 4,427,048).

Osaka et al. show and teach a skylight (10) comprising at least one light conveying structure (12) having a shroud (26) engaging the light conveying structure (12) to define a light passageway therethrough, a dome shaped transparent cover (46) covering an upper end of the light conveying structure, and a diffuser cover (44) covering a lower end of the structure, a shroud (26) having a plurality valve elements/ or louvers (20, 22, 24) being separated from each other, each valve element (20, 22, 24) being turned on a respective axles (82), the valves elements (20, 22, 24) being pivotable between an open and closed configurations to unblock and block the light passageway of the skylight respectively by an actuator such as a drive module (16), the drive module (16) being either driven by

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a DC motor (174) via a gear trains (176) through an electrical switch (166) or by a remote control (170) via a circuit (see col. 6, lined 1-18).

2. Claims 1-2, 5-8, 22-23, and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Freeman (US Patent No.4,505,069).

Freeman discloses and teach a skylight comprising at least one light conveying structure (48) having an upper end covered by a transparent dome cover (50) and a lower end covered by a cover (26), a shroud (14) having sides (16, 18) engaging the light conveying structure (52, 54) to define a light passageway therethrough, at least first and second valve elements (34-1 to 43-4 ...) disposed and secured in the shroud, the shroud (14) having a lip (28) for engaging the valve elements, the valve elements being separated from each other, each valve element (i.e., 34-1) being turned on a respective axle and pivotable between an open configuration to open a light passageway of the skylight, and a closed configuration to block the light passageway, the valves elements (34-1 ...) being pivoted by an actuator, wherein the actuator may include a drive module (40) driven by a DC motor (44) via a crank (42) through either an electrically connected switch or a remote control (46) via a electrical circuit (see col. 3. lines1-40) and an electrical power supply operating to supply power inherently at voltages

in a range from about one hundred volts (100V) to about two hundred seventy volts (270V).

Claim Rejections - 35 USC § 103

3. Claims 1-9, 13-17, and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang et al. '782 and further in view of Dayus (US Patent No. 4,628,954).

Zhang et al. show and teach a skylight (100) comprising at least one light conveying structure (105) having an upper end covered by a dome shaped transparent cover (160), a lower end covered by a ceiling-mounted diffuser cover (130), and a tubular element extending therebetween, the tubular element formed by a plurality of tubular sections coaxially coupled together, a shroud engaged with the light conveying structure and defining a light passageway (105), and the shroud having a shutter (200) mounted therein, the shutter (200) having at least one valve element (202) pivotable about an axle (204) within the shroud, the axle being a shaft extending outward through the shroud and operated by an actuator (201) between an open configuration in which the light passageway is open, and a closed configuration in which the light is blocked, the actuator (201) actuated by either manually controlled electrical switch or automatically controlled wirelessly remove control; wherein a mechanical control (430) is either operated by a remote

control (480) or simply employed by an off-on switch (456) and manually controlled rheostat (457), a power supply applies to the shutter actuator with suitable voltages either about 100V or 270V, and the shutter actuator can be an electric motor to drive a rack and pinion gear set (1310, see Fig. 13b) or may be applied by electrical control circuit (see col. 24, lines 18-59, and Fig. 2a).

Although Zhang et al. does not define having the shutter having two valve elements being separated from each other and coaxially engaged with the light conveying structure and the shroud having a height less than a diameter defined by two valves and having a lip circumscribing an inner surface of the shroud to be engaged by the valve element at the closed configuration as claimed, Dayus teaches a shroud for mounting over a tubular housing, the shroud comprising two separated valve elements being pivotally connected to an axes for opening and closing the tubular housing in a suitable environmental conditions, wherein the shroud having an outer flange (26) extending outwardly from an outer surface of the shroud for allowing easily to mount the shroud between two sections of the tubular housing , and the shroud having a lip (28) circumscribing an inner surface of the shroud, two valve elements (34, 34) pivotally mounted on a shaft (36, 38) respectively and engaging the lip in a closed configuration, and the shroud having a height less than a diameter of the valve. It would have been obvious to one

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ordinary skill in the art, at the time the invention was made, to modify the skylight of Zhang et al. having a shroud mounted between two tubular sections on the middle portion of the skylight tubular structure and the shroud having at least two valves instead of a single valve pivotally mounted on a shaft inside of the shroud and driven by an actuator, and the shroud having a lip extending circumscribing an inner surfaced of the shroud for supporting the valves as taught by Dayus for providing the skylight having a shroud having a mounted mechanism to be easily assembled and having separated valves instead of a single valve for selectively controlling the opening and closing area of the tubular structure of the skylight to selectively control the light passing through the skylight.

4. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dayus (US Patent No. 4,628,954), and in view of Zhang et al. '782.

Dayus teaches a valve assembly that is capably mounted for a skylight, comprising: a shroud having a tubular configuration, an outer flange (26) extending outwardly from an outer surface of the shroud for allowing to be easily assembled to the skylight, and a lip (28) circumscribing an inner surface of the shroud, two valve elements (34, 34) pivotally mounted on a shaft (30) by axles (36, 38) respectively, the valve elements being rotated within the shroud between an

open configuration to define a light passageway therethrough, and a closed configuration, wherein to block the light passageway, wherein valves engage to and supported by the lip of the shroud in the closed configuration, and the shroud having a height less than a diameter of the valve and engaging the lip in a closed configuration. Dayus does not define the valve elements being controlled by an actuator operated by a power supply at voltages in an arrange between 100V to 270V as claimed. Zhang et al. teaches a skylight having a valve assembly (200, see Fig. 2b; or 1310, see Fig. 13b) mounted thereon, the valve assembly having at least one valve element (202 or 1320) being rotatably mounted on a shroud by a support shaft (204, or 1329) and driven by an actuator (201) which can be an electrical motor driven by a power supplied by a power supply with suitable voltages either about 100V or 270V. It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the valve assembly of Dayus having the valve elements being operated by an actuator driven by electrical power supply at a suitable range of voltages as taught by Zhang et al. instead of mechanical manual operation since it has generally been recognized that the use of a conventional control to automate a previously manual operation involves only ordinary skill in the art.

Allowable Subject Matter

5. Claims 10-11 and 19-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Argument

6. Applicant's arguments with respect to claims 1-2, 5-9, 13-15, 17-18, 22-23, and 26-27 under U.S.C. 102 as being anticipated by Zheng et al. '782, and specifically to the feature of separate valve elements has been considered. This feature was not specifically and previously claimed. Therefore, this argument is deemed to be moot in view of the new grounds of rejection.

7. Applicant's arguments with respect to claims 13-16 under U.S.C. 102 as being anticipated by Dayus '954, and specifically to the feature of the valve assembly comprising a power supply at a specific range of voltages has been considered. This feature was not specifically and previously claimed. Therefore, this argument is deemed to be moot in view of the new grounds of rejection.

8. In response to applicant's argument that there is no suggestion to combine the references Zheng et al. '782 with Dayus '954, the examiner recognizes that

obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Zheng et al. teaches a skylight having a valve assembly mounted in a tubular structure being operated by an suitable actuator driven by a power control. Dayus teaches a valve assembly mounted in a tubular structure and operated by suitable actuator driven by mechanical control. Both references address precisely the same problem of using valve elements for controlling opening and closing the areas inside of a tubular structure. Second, Dayus is only used as a teaching reference to teach the valve assembly being mounted in a tubular structure would have been obvious to be modified by one ordinary skill in the art to substitute the single valve element by two valve elements for allowing to be selectively control the opening or closing area of the tubular structure. The recitations with respect to the manner in which a claimed apparatus is intended to be employed such as whether the valve elements being used for purpose of air flow control or light control does not differentiate the

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claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Therefore, the rejection stand granted.

ACTION IS FINAL

9. Applicant's amendment necessitated the new grounds of rejection.

Accordingly, THIS ACTION IS MADE FINAL. See M.P.E.P. ' 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 C.F.R.

' 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. ' 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Inquiry Contacts

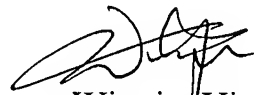
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 571-

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272-6870. The examiner can normally be reached on M-F (9:30-6:30), Second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Winnie Yip
Primary Examiner
Art Unit 3637

wsy
July 8, 2005

Replacement Sheet

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